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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,472	05/15/2002	Jorn Leiber	35-222	8437
7590	10/14/2004		EXAMINER	
Nixon & Vanderhye 1100 North Glebe Road 8th Floor Arlington, VA 22201-4714			HUBER, PAUL W	
			ART UNIT	PAPER NUMBER
			2653	

DATE MAILED: 10/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/030,472	<b>Applicant(s)</b> LEIBER ET AL.	
	<b>Examiner</b> Paul Huber	<b>Art Unit</b> 2653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 11 is/are rejected.
- 7) ☒ Claim(s) 6-10 and 12-16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>05152002</u> . | 6) <input type="checkbox"/> Other: ____.  |

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The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Yokoyama et al. (USP-5,312,713).

Regarding claims 1-3, Yokoyama et al. discloses a data storage medium, having an optical information carrier which comprises a polymer carrier which is set up to store information, and a layer which comprises a dye. See, for example, figures 1A & 1B, which teach that data storage medium includes a polysilane (polymer) material, and a oxo metallic phthalocyanine pigment (dye) which may be mixed with a binder polymer. The oxo metallic phthalocyanine (dye) can be optically changed locally, i.e., heated portion 16 or 26 is decolored or bleached, for the purpose of storing information.

Regarding claims 4 & 5, the "organic polysilane decomposes by heating the organic polysilane to a temperature equal to or higher than its pyrolyzing point. Then, the decomposition product decolors the oxo metallic phthalocyanine pigment by reacting on the oxo metallic phthalocyanine pigment. Therefore, as shown in FIG. 1A, by locally heating a recording layer 14 on a substrate 12 of the information recording medium with a laser beam 10, etc., a heated portion 16 is decolored (that is, the light absorbance is changed)..." (col. 3, lines 34-43). Accordingly, the refractive index of the polymer carrier can be changed locally by heating, and the polymer carrier is assigned an absorber as claimed.

Regarding claim 11, the polymer carrier comprises a polymer film 28. See figure 1B which illustrates that the top layer of the carrier is an organic polysilane.

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Claims 6-10 and 12-16 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication should be directed to Paul Huber at telephone number 703-308-1549.

A handwritten signature in black ink, appearing to read 'Paul Huber', is positioned above the printed name and title.

Paul Huber  
Primary Examiner  
Art Unit 2653

pwh  
October 12, 2004